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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,839	08/06/2003	Shinji Sugatani	021331A	8605

23850 7590 09/22/2004

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EXAMINER

WEISS, HOWARD

ART UNIT	PAPER NUMBER
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2814

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/634,839	SUGATANI ET AL.	
	Examiner	Art Unit	
	Howard Weiss	2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 ~~is~~ are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 ~~is~~ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Attorney's Docket Number: 021331A

Filing Date: 8/6/03

Continuing Data: Division of 10/289,295 (11/7/02 now U.S. Patent No. 6,639,280)

Claimed Foreign Priority Date: 1/17/02 (JPX)

Applicant(s): Sugayani et al. (Sekino)

Examiner: Howard Weiss

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1 to 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (JP 09-246505), Freestone et al. (U.S. Patent No. 3,054,709) and Lin et al. (U.S. Patent No. 6,596,185).

Kato shows most aspects of the instant invention (e.g. Figures 1) including

- forming a laminated substrate **1** consisting of a support layer **2**, an insulating layer **3b** and a device layer **4**

- said device and support layer consist of single crystal silicon and their crystalline axes are $\langle 110 \rangle$ and shifted by 45°

Kato does not show the forming of scribe lines parallel to said axes, semiconductor devices formed between said scribe lines, grooves form through said device layer, splitting the substrate along said scribe lines and wirings form parallel to said axes. Freestone et al. teach to form scribe lines (Figure 2) parallel on a principle plane (and, therefore, parallel to a principle axis) to form wafers with smooth edges and less strain (Column 1 Lines 39 to 41). It would have been obvious to a person of ordinary skill in the art at the time of invention to form scribe lines parallel to the principle axis as taught by Freestone et al. in the process of Kato to form wafers with smooth edges and less strain.

Lin et al. teach (e.g. Figures 2) to form grooves **112** through the device layer **108** and to form devices **102** between scribe lines **104** to reduce stress-related problems resulting from separating components (Column 1 Lines 30 to 55). It would have been obvious to a person of ordinary skill in the art at the time of invention to form grooves through the device layer and to form devices between scribe lines as taught by Lin et al. in the process of Kato to reduce stress-related problems resulting from separating components.

Response to Arguments

3. Applicant's arguments filed 7/16/04 have been fully considered but they are not persuasive. In reference to Freestone et al. description of the relation of the scribe line to the principle axis direction, Freestone et al. states (as quoted by the Applicants): "The slice may be of about 0.020" thick and is preferably cut from the ingot in a manner such that the face of the slice is parallel to a principal plane, preferably a 1.1.1. plane, of the crystal." However, if the principle plane chosen was one of the other principle planes, say the 1.0.0. plane as described in Column 2 Lines 21 to 25, then the scribe would be on a plane face that could be parallel to a

direction of a crystallographic axis (see Figure 2). The direction is an obvious engineering choice to one having ordinary skill in the art at the time the invention was made since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Additionally, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). In view of these reasons and those set forth in the present office action, the rejections of the stated claims stand.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. The faxing of such papers must conform with the notice

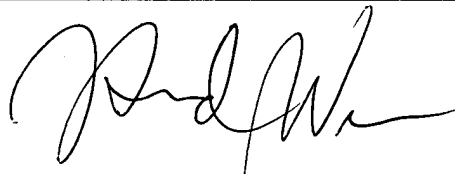
Art Unit: 2814

published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(703) 872-9306**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Weiss at **(571) 272-1720** and between the hours of 8:00 AM to 4:00 PM (Eastern Standard Time) Monday through Friday or by e-mail via **Howard.Weiss@uspto.gov**.

7. The following list is the Examiner's field of search for the present Office Action:

Field of Search	Date
U.S. Class / Subclass(es): 438/ 479, 462, 517	thru 9/20/04
Other Documentation: none	
Electronic Database(s): EAST	thru 9/20/04



Howard Weiss
Examiner
Art Unit 2814

HW/hw
20 September 2004